

REMARKS

Claims 1, 3-9 and 11-13 are pending, of which claims 12 and 13 are withdrawn from consideration.

Applicants have reviewed and considered the Office Action mailed on March 9, 2006, and the references cited therewith. Applicants respectfully request reconsideration and allowance of all claims in view of the following remarks.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

Claims 1, 3, 4-8 and 11 are Patentable over MacFarlane, Burkett and Beranek under §103

Claims 1, 3, 4-8 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2001/0042081 A1 for MacFarlane et al. ("MacFarlane") in view of U.S. Patent No. 6,671,853 to Burkett et al. ("Burkett") and U.S. Patent No. 6,226,642 to Beranek "Beranek"). In response, the Applicants herein amend claims 1 and 4 and respectfully traverse the rejection.

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

503877-1

As discussed in Applicants' response to the Office Action mailed March 9, 2006, the combination of MacFarlane and Burkett fails to establish a *prima facie* case of obviousness, because the combination of MacFarlane, Burkett and Beranek does not teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest wherein each one of said plurality of nodes comprises at least one user manipulable property, as claimed.

Claim 1 recites, *inter alia*, "translating said binary file into a document tree containing a plurality of nodes, wherein each one of said plurality of nodes represents said subset of style information, wherein each one of said plurality of nodes comprises at least one user manipulable property."

The Examiner concedes that MacFarlane fails to teach or to suggest compressing said presentation code including resolved style information to provide a binary file, said resolved style information being within said binary file and adapted to enable client manipulation. (See Final Office Action, p. 3, ll. 17-19.) However, the Examiner alleges that Burkett bridges the substantial gap left by MacFarlane.

Burkett fails to bridge the substantial gap left by MacFarlane because Burkett fails to teach or to suggest wherein each one of said plurality of nodes comprises at least one user manipulable property. Burkett specifically teaches identifying static and changeable portions of a document and writing changeable portions in a tagged, parseable format, while writing only the static portions in a serialized binary output format. (See Burkett, col. 1, ll. 13-17; col. 3, l. 64 – col. 4, l. 9, col. 15, ll. 39-55, claim 1, emphasis added.) In otherwords, unlike the Applicants' invention that teaches that each one of the said plurality of nodes comprises at least one user manipulable property, Burkett teaches that only static portions are written in a binary format, while the changeable portions of a document are only written in a tagged, parseable format (i.e. not in binary).

Moreover, Burkett fails to teach or suggest modifying at least one of said plurality of nodes in response to a received user interaction. Rather, Burkett teaches that only the XML tagged syntax portions are readily modifiable without requiring the serialized binary streams. (See Burkett, col. 8, ll. 24-53, emphasis added.)

Furthermore, Beranek fails to bridge the substantial gap between MacFarlane and Burkett and Applicants' invention as claimed in at least independent claim 1. Beranek discloses content modification of internet web pages for a television class display.

Beranek also teaches away from the Applicants' invention because Beranek teaches that a document is parsed and dynamically rewritten at a client machine. (See Beranek, col. 3, ll. 11-34.) In contrast, the Applicants' invention teaches that the style information is resolved before propagating the resolved style information in a binary file to a client. As such, claim 1 is patentable over the combination of MacFarlane, Burkett and Beranek under §103.

Claims 3, 4-8 and 11 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1, while adding additional elements and further defining elements. Therefore, claims 3, 4-8 and 11 are also patentable over the combination of MacFarlane, Burkett and Beranek under §103 for at least the reasons given above with respect to claim 1. Therefore, the rejection should be withdrawn.

Claim 9 is Patentable over MacFarlane, Burkett, and Hill under §103

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over MacFarlane in view of Burkett as applied to claim 1 and further in view of U.S. Patent No. 6,023,714 to Hill et al. ("Hill"). The rejection is traversed.

This ground of rejection applies only to dependent claims and is predicated on the validity of the rejection under 35 U.S.C. §103 for the corresponding independent claim. Since the rejection of the corresponding independent claim under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office that any other additional references supply that which is missing from MacFarlane and Burkett to render the independent claims unpatentable, this ground of rejection cannot be maintained.

THE SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed

NOV 16 2006

PATENT
Attorney Docket No.: TVW/APP49US
Serial No. 10/675,918
Page 8 of 8


that the secondary references are no more pertinent to Applicants' disclosure than the primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, It is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/16/06



Eamon J. Wall
Registration No. 39,414
Attorney for Applicant(s)

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808